

YUDA *et al.*, SN 10/694,809  
Amdt. dated 11/24/2004  
Reply to OA mailed 08/24/2004

Dkt. 520.43233X00/NT1290US  
Page 10

### REMARKS

This Amendment is responsive to the Office Action identified above, and is further responsive in any other manner indicated below.

### PENDING CLAIMS

Claims 1-12 were pending in the application, under consideration and subject to examination at the time of the Office Action. Unrelated to any prior art, scope or rejection, appropriate Claims have been amended, added or deleted in order to adjust a clarity and/or focus of Applicant's claimed invention. That is, the amendments to the claims are unrelated to any prior art or scope adjustment, and are simply clarified claims in which Applicant is presently interested. At entry of this paper, Claims 1-3 and 13-33 are now pending in the application for consideration and examination.

### §101 REJECTION -TRAVERSED

Claims 8-11 have been rejected under 35 USC §101 for the concerns listed at Item 3 on page 3 of the Office Action. Applicant respectfully traverses. However, it is respectfully noted that claims 8-11 have been cancelled without prejudice or disclaimer. Based upon the foregoing, reconsideration and withdrawal of the §101 rejection of the above-referenced claims are respectfully requested.

YUDA *et al.*, SN 10/694,809  
Amdt. dated 11/24/2004  
Reply to OA mailed 08/24/2004

Dkt. 520.43233X00/NT1290US  
Page 11

### **35 USC §112, 1<sup>ST</sup> PARAGRAPH REJECTION - OBSOLETE VIA AMENDMENT**

Claims 1-12 have been rejected, under 35 USC §112, first paragraph, for the concerns listed at Item 5 spanning pages 3 and 4 of the Office Action. Unrelated to any rejection, scope or prior art, appropriate claims have been cancelled (without prejudice or disclaimer), and other ones of the claims have been carefully amended. Traversal is appropriate, but such objection/rejection has been rendered obsolete by the present cancellation of claims and clarifying amendments to Applicant's claims. More particularly, Applicant respectfully submits that, contrary to the statement of rejection, the discussion of a second database storage for storing standardization parameter data that are criteria on judgment whether the plural parts are standard parts or not is discussed in the specification as filed, *e.g.*, at page 6, line 21 through page 7, line 13. Additionally, the rejection indicates that it is not clear from the specification how the production quantity data is used to select the standard parts. Applicant respectfully points out that such selection is discussed in the specification as filed at, *e.g.*, page 8, line 6 through page 13, line 10. Accordingly, Applicant respectfully submits that the above comments show that Applicant's invention was sufficiently described/taught within Applicant's original disclosure. Based upon the foregoing, reconsideration and withdrawal of the rejection under 35 USC §112, first paragraph, is respectfully requested.

### **REJECTION UNDER §112, 2ND PAR. - OBSOLETE VIA AMENDMENT**

Claims 1-12 have been rejected under 35 USC §112, second paragraph, as being indefinite for the concerns listed at Item 7 spanning pages 4-6 of the Office

YUDA *et al.*, SN 10/694,809  
Amdt. dated 11/24/2004  
Reply to OA mailed 08/24/2004

Dkt. 520.43233X00/NT1290US  
Page 12

Action. Unrelated to any prior art, scope or rejection, appropriate ones of the claims have now been cancelled (without prejudice or disclaimer), and other ones of the claims have been carefully reviewed and carefully amended, to address the Office Action listed concerns. As the foregoing is believed to have addressed all §112, second paragraph concerns, reconsideration and withdrawal of the §112, second paragraph rejection are respectfully requested.

#### **REJECTIONS UNDER 35 USC §102 - TRAVERSED**

The 35 USC §102 rejections of Claims 1-12 as being anticipated by Gear *et al.* (US 6,625,607 B1) and as being anticipated by Uchida *et al.* (US 2001/0023376 A1) are respectfully traversed. Such rejections have been rendered obsolete by Applicant's present clarified claims, and accordingly, traversal arguments are not appropriate at this time. However, Applicant respectfully submits the following to preclude renewal of any such rejections against Applicant's clarified claims.

All descriptions of Applicants disclosed and claimed invention, and all descriptions and rebuttal arguments regarding the applied prior art, as previously submitted by Applicant in any form, are repeated and incorporated herein by reference. Further, all Office Action statements regarding the prior art rejections are respectfully traversed.

To reiterate the requirements to support a rejection under 35 USC §102 as indicated in the decision of *In re Robertson*, 49 USPQ2d 1949 (Fed. Cir. 1999), each and every element as set forth in the claim is found, either expressly or inherently described in a single prior art reference. Moreover, the Court pointed out that

YUDA *et al.*, SN 10/694,809  
Amdt. dated 11/24/2004  
Reply to OA mailed 08/24/2004

Dkt. 520.43233X00/NT1290US  
Page 13

inherency, however, may not be established by probabilities or possibilities.

The mere fact that a certain thing may result from a given set of circumstances is not sufficient.

The cited prior art does not adequately support a §102 anticipation-type rejection because it does not, at minimum, disclose (or suggest) the “accumulating” limitations of Applicant’s clarified claims, *i.e.*,

an accumulation range input device to set a predetermined accumulation parameter range to be used with respect to a subject parameter of interest,

an accumulation unit to use data from the first database storage to accumulate, for each selected parameter value of a plurality of selected parameter values, an accumulation total corresponding to ones of the plural candidate parts having actual parameters falling within the predetermined accumulation range as measured from the selected parameter value, so as to determine a plurality of accumulation totals corresponding respectively to the plurality of selected parameter values, and

a standard parts judging unit to compare ones of the plurality of accumulation totals to each other, to select which candidate part is selected as the standard part.

In addition to the foregoing, the following additional remarks from Applicant’s foreign representative are also submitted in support of traversal of the rejection and patentability of Applicant’s claims.

In Gear *et al.*, plural kinds of similar parts are compared in accordance with attributes of their shapes, *i.e.*, the “metadata” means the contour attributes.

In the present invention, the data includes volume, surface area, mass, production quantity, etc. The present invention has such advantages that it is possible to standardize the parts taken into consideration the actual production data and cost.

YUDA *et al.*, SN 10/694,809  
Amdt. dated 11/24/2004  
Reply to OA mailed 08/24/2004

Dkt. 520.43233X00/NT1290US  
Page 14

In Gear *et al.*, "the elimination for redundant part models within the various part libraries" should not be understood to standardize parts because Gear *et al.* deals only with shape or contour of parts. Gear *et al.* cannot consider the actual production. This means that the cost is one of the most important factors for designing of parts in the production business.

In the present invention, the actual production amount (second database) is taken into judgment, which is not found in Gear *et al.*

In Uchida *et al.*, the invention comprises in combination a part management system and other systems such as cost, production, etc. (paragraphs 0034, 0035 of Uchida *et al.*), and displays the results. In paragraph (0042) of Uchida *et al.*, an apparatus simply displays the order of display using the priority class and distribution records. The propriety class is treated as it is already in the database at the time of inspection. If not, the priority class is not utilized.

In the present invention, the accumulated actual production quantity data (second database) is utilized. In the present invention, the actual production data on the similar parts are accumulated to utilize. If there are many kinds of similar parts and if the number of the production of the respective parts is small, not only the production data of the respective parts is used, but also the total production amount (accumulated amount) of the similar parts is considered to select the standard parts.

Uchida *et al.* does not utilize the accumulated production data. The present invention can determine the standard parts, but Uchida *et al.* can not. Uchida *et al.* only decides the order of display, even though the actual production data might be utilized. In Uchida *et al.*, "the earlier the start of distribution and the larger the

YUDA *et al.*, SN 10/694,809  
Amdt. dated 11/24/2004  
Reply to OA mailed 08/24/2004

Dkt. 520.43233X00/NT1290US  
Page 15

quantity is, the higher the priority" means that only the actual production of the respective parts is considered, and the priority of the larger production amount of parts is given. In other words, if there are two similar parts and their production are large, both of them are displayed as parts with high priority.

As a result of all of the foregoing, it is respectfully submitted that the applied art would not support a §102 anticipation-type rejection (or a §103 obviousness-type) rejection of Applicant's claims. Accordingly, reconsideration and withdrawal of such §102 rejections, and express written allowance of all of the rejected claims, are respectfully requested.

#### **RESERVATION OF RIGHTS**

It is respectfully submitted that any and all claim amendments and/or cancellations submitted within this paper and throughout prosecution of the present application are without prejudice or disclaimer of any scope or subject matter. Further, Applicant respectfully reserves all rights to file subsequent related application(s) (including reissue applications) directed to any/all previously claimed limitations/features which have been subsequently amended or cancelled, or to any/all limitations/features not yet claimed, *i.e.*, Applicant continues (indefinitely) to maintain no intention or desire to dedicate or surrender any limitations/features of subject matter of the present application to the public.

YUDA *et al.*, SN 10/694,809  
Amdt. dated 11/24/2004  
Reply to OA mailed 08/24/2004

Dkt. 520.43233X00/NT1290US  
Page 16

### EXAMINER INVITED TO TELEPHONE

The Examiner is invited to telephone the undersigned at the local D.C. area number 703-312-6600, to discuss an Examiner's Amendment or other suggested action for accelerating prosecution and moving the present application to allowance.

### CONCLUSION

In view of the foregoing amendments and remarks, Applicant respectfully submits that the claims listed above as presently being under consideration in the application are in condition for allowance. Accordingly, early allowance of such claims is respectfully requested.

This Amendment is being filed within the shortened statutory period for response set by the 24 August 2004 Office Action, and therefore, no Petition or extension fee is required. To whatever other extent is actually necessary, Applicant respectfully petitions the Commissioner for an extension of time under 37 CFR §1.136. Attached is a Form PTO-2038 authorizing payment of the additional claims fees. Please charge any actual required fee to ATS&K Deposit Account No. 01-2135 (as Case No. 520.43233X00).

Respectfully submitted,



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Attachment:  
PTO-2038 (Fee Code 1202)